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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,718	04/05/2001	Joseph Leo Nothnagel	71029	5597

22242 7590 07/16/2003

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EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/028.718

Applicant(s)

Nethnager et al

Examiner

T. Yoon

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 6-9-03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-4, 6-9, 23-26 and 28-40 is/are pending in the application.
- Of the above claim(s) 28-40 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4, 6-9 and 23-26 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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### DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, 6-9 and 23-26, drawn to a polymeric vehicle, classified in class 525, subclass 123+.
- II. Claims 28-40, drawn to a polymeric vehicle, classified in class 525, subclass 395+.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination also uses polymers other than alkyd resins. The subcombination has separate utility such as a coating.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Krueger on July 11, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-4, 6-9 and 23-26.

Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 28-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-4, 7-9 and 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited “wherein (the) isocyanate compound”, “a polymeric isocyanate compound”, a (blocked) isocyanate compound” and a (unblocked) isocyanate compound” lack an antecedent basis since “the cross-linking agent is selected from the group consisting of dimerized or trimerized polyisocyanate, triisocyanate, tetraisocyanate and mixtures thereof” is recited in claims 1, 6 and 23.

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The recited "SSIPA" in claim 1, 6, and 23 are indefinite, and a full name is required at least in the first occurrence.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-9 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/31021 A1 in view of Taniguchi et al (US 5,202,364) or Nienhaus et al (US 5,670,600).

Note that the instant application is a CIP which has an effective filing date of April 5, 2001.

WO teaches low VOC alkyd dispersions having a solid content of 35-35 wt% and a viscosity of 3 to 18 poise (300-1800 CPS) in abstract and table 6 and at page 16. Said alkyd resin has an acid value of 12-25 (claim 4) and said dispersion is free of an organic solvent (claims 6 and 8). Also, alkyd dispersions is free of an emulsifier. The particle size of 0.01 to 1.0 microns (10-1,000 nm) which encompasses the instant size is taught at page 17, lines 1-5. Batch No. 008 of said table 6 shows a viscosity of 13.2 poise and a particle size of 95-106 nm. Polyisocyanate crosslinker is taught at page 18, lines 3-6. Said alkyd resin of WO would meet the instant solubility inherently since both alkyd resin are deemed to be same or at least similar.

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The instant invention further recites the cross-linking agent being selected from the group consisting of dimerized or trimerized polyisocyanate, triisocyanate, tetraisocyanate and mixtures thereof'.

However, such cross-linking agents are well known in the art as taught by Taniguchi et al (col. 7, line 39) and Nienhaus et al (col. 10, lines 28-42).

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the art well known cross-linking agents of Taniguchi et al or Nienhaus et al in WO since WO teaches employing various polyisocyanate crosslinkers absent showing otherwise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/July 14, 2003



TAE H. YOON  
PRIMARY EXAMINER